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01-14-04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:
CROWDER et al.

Serial No.: 09/975,593

Filed: October 10, 2001

Atty. File No.: 3123-379

For: SUSPENSION SWAGE PLATE WITH
APPLIED SOLID FILM LUBRICANT
AND METHOD OF ASSEMBLING THE
SAME

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Mailstop: AF

Dear Sir:

Applicants hereby petition the Commissioner under Rule 1.144, to reverse the
Examiner's second and final restriction requirement found in Paper No. 11, the Office Action
dated October 6, 2003.

The Examiner issued a first Restriction Requirement in the first Office Action dated
March 19, 2003 (Paper No. 7). Applicant responded to this first restriction requirement in the
Response filed by a certificate of mailing on April 10, 2003, received by the Patent Office on
April 15, 2003. In the next Office Action (Paper No. 9) dated May 28, 2003, the Examiner made
final the first restriction requirement, and further restricted original Group II (claims 13-29) into
new Groups III (claims 13-21) and Group IV (claims 22-29). Applicants have canceled claims 1-
12 and 30 (Group I). The Examiner's second restriction requirement was made final in the Paper

) Group Art Unit: 3729
)
) Examiner: Kim, P.
)
PETITION UNDER RULE 1.144

CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS
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SHERIDAN ROSS P.C.

BY: *Christine Jaquet*

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No. 11; therefore, the Examiner stated that claims 22-29 and 31 (Group IV) were drawn to a non-elected invention wherein a complete reply to this final restriction must include either cancellation of these non-elected claims or other appropriate action. Accordingly, the matter is ripe for petition under Rule 1.144.

In the Office Action dated October 6, 2003, the Examiner articulated new reasons for insisting upon restriction in light of Applicant's previous amendment to claim 22, the sole independent claim in Group IV. In the Office Action, the Examiner stated that

"even though Applicant amended claim 22 to delete the limitation of applying a lubricant film [to the] inner surface of the swage, the combination of the Group I [III] (claims 13-21) does not require swage contact surfaces and the lubricant film provides a subsequent de-swaging process as recited in claim 22."

There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) the inventions must be independent or distinct as claimed; and (B) there must be a serious burden on the Examiner if restriction is required. (MPEP Section 803).

In the present case, the Examiner asserts that Groups III and IV are related as combination and sub-combination (MPEP Section 806.05(c)). Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the sub-combination as claimed for patentability; and (2) that the sub-combination has utility by itself or in other combinations. To support a requirement for restriction in this combination/sub-combination relationship, both two-way distinctness and the reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search.

First, it is asserted that the combination as claimed does require the particulars of the sub-combination as claimed. The Examiner stated that the combination of Group III (claims 13-21) does not require swage contact surfaces. Claim 13 is the sole independent claim within this group. Among other elements, method claim 13 requires an outer surface of the swage boss (shown in the figures as swage boss 48). Claim 13 also requires an opening in the actuator arm (this opening in the actuator arm defined by interface or wall 38 as shown in the figures). The description specifically describes where lubrication should occur, namely, on surface 38, or on outer surface of swage boss 48, or both (Page 10, lines 8-11). These surfaces correspond to the claimed swage contact surfaces. Clearly, claim 13 requires swage contact surfaces; therefore, two-way distinctness does not exist because the combination recites the particulars of the sub-combination.

Applicants also note that the Examiner has not articulated proper reasons for insisting on restriction. The Examiner indicated that the invention of Group III is classified in class 29, sub-class 603.03; and that Group IV is classified in class 29, sub-class 603.07. (See Paper No. 9). Applicant disagrees with the classification of Group IV. Sub-class 603.07 as recited in the Manual of Patent Classification describes this sub-class as “fabricating head structure or component thereof: (This sub-class is indented under sub-class 603.01. Process including producing or manufacturing the head, core, or part thereof).” Applicants note that sub-class 603.02 is entitled “including this assembly step”. Even if Group IV is more properly classified under sub-class 603.02 as opposed to sub-class 603.07, both sub-class 603.02 and sub-class 603.03 are both simply indented under sub-class 603.01. Accordingly, there does not appear to be any requirement for different fields of search or an indication of separate statuses in the art.

Therefore, even if two-way distinctness exists, proper reasons for insisting on restriction do not exist.

Filed simultaneously herewith is an Appeal to the Examiner's final rejection of claims 13-21 under 35 U.S.C. § 103.

Therefore, Applicant requests that the Examiner's final restriction requirement be reversed, and that claims 22-29 and 31 should be allowed to be examined in the present application.

Enclosed herewith is the required fee under Section 1.17(h) of \$130.00. Any shortcoming to this fee may be charged to Deposit Account No. 19-1970.

Respectfully submitted,

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Date: 1/6/64